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PATENT APPLICATION

ATTORNEY DOCKET NO. 100201014-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Robert C. LEHR, et al.

Confirmation No.: 8861

Application No.: 10/045,151

Examiner: Michael J. Fisher

Filing Date: January 15, 2002

Group Art Unit: 3629

HARDWARE PAY-PER-USE

Title:

Mail Stop Appeal Brief - Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on January 10, 2008.

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

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Respectfully submitted,

Robert C. LEHR, et al.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/045,151
Applicant : Robert C. Lehr et al.
Filed : January 15, 2002
Title : Hardware Pay-Per-Use
TC/A.U. : 3629
Examiner : Michael J. Fisher
Docket No. : 100201014-1
Customer No. : 022879

Mail Stop Reply Brief - Patents
Commissioner of Patents
P.O. Box 1450
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REPLY BRIEF UNDER 37 C.F.R. §41.37



RESPONSE TO EXAMINER'S ANSWER

The Examiner's Answer fails to overcome the reasons for patentability set forth in the Appellant's Appeal Brief, filed August 21, 2007. In this Reply Brief, Appellant responds to the Examiner's Answer and provide additional clarification and reasons why the cited references do not anticipate or render the pending claims obvious.

The pending claims are patentable over the cited prior art. The March 22, 2007 Final Office Action rejects claim 47 under 35 U.S.C. §112, ¶1, claims 1, 2, 9, 13, 18-25, 27, 29 - 31, 35, 37, 39, 40, 45, 46, and 50 under 35 U.S.C. §102(b) over the Plain Old Telephone System (POTS), claims 1 - 4, 8 - 12, 16, 18 - 25, 27, 28, 32, 35, 37 - 41, 44, 45, 48, and 50 - 54 under 35 U.S.C. §102(b) over U.S. Patent 5,745,884 to Carnegie et al. (hereafter Carnegie) and claims 5 - 7, 13 - 15, 26, 29 - 31, 33, 34, 36, 42, 43, 46, 49, and 55 - 61 under 35 U.S.C. §103(a) over Carnegie. In the Examiner's Answer, the rejections under 35 U.S.C. §112, ¶1 and §102(b) over the POTS are withdrawn but the rejections under 35 U.S.C. §102(b) and §103(a) over Carnegie are maintained. However, the rejections set forth in the Final Office Action, and maintained in the Examiner's Answer, must fail because Carnegie does not teach or suggest each and every limitation of independent claims 1, 18, 19, 20, 27, 37, 45, and 53. Since the references fail to teach or suggest all of the claim limitations, the Final Office Action fails to establish a *prima facie* case of anticipation or a *prima facie* case of obviousness and the claims must be allowed.

Carnegie Does Not Disclose or Suggest a Hardware pay Per Use System

Considering claim 1, Examiner's Answer repeats the Final Office Action basis for rejection, asserting that Carnegie discloses all that is claimed including "a hardware pay per use system (title) comprising one or more hardware products (col 4, lines 53 - 56), a metering agent that acquires metrics data (306, 316, as best seen in fig. 3), and a usage repository that generates reports on the received data (308, 318).

The Examiner's position is totally without support. First, the title of Carnegie's patent is "System and Method for Billing Data Grade Network Use on a Per Connection Basis." (emphasis supplied) That is, Carnegie does not bill a user based on an operation of the computer, but instead, bills the user each time the user's computer connects to a network. In Carnegie's system, there are no metrics data recorded or reported, because there is no need for this information.

Second, the Examiner does not even bother to address each limitation of claim 1. For example, claim 1 recites that the acquired metrics data is “related to an operation at the one or more hardware products.” Claim 1 also recites that the generated usage reports “[relate] to the operation of the one or more hardware products.” Claim 1 further recites “ the metering mechanism includes a hardware device separate from the one or more hardware products.” The Examiner has not addressed these elements of claim 1.

Third, nowhere in Carnegie’s disclosure is anything more than billing based on connection ever disclosed or suggested. Starting with the Abstract, Carnegie discloses that “remote users may be billed, on a per connection basis,” and “[b]illing for this service is easily facilitated on a per user, per connection basis, since establishment [of the connection] creates a recordable billable event for which either the remote user or the destination server 130 may be invoiced.”

Turning to the Figures, Figure 3, which the Examiner asserts best shows a metering agent that acquires metrics data, clearly shows, instead, that billing is based on connection, and connection only. The word metrics, or any word suggestive of this parameter, is totally lacking from Figure 3. Consider step 306: “AP records destination, remote user, date and time”; step 308: “AP SYSOP bills destination, for connection”; step 316: AP records destination, remote user, date and time”; step 318: AP SYSOP bills remote user for connection”; step 326: “AP records destination, remote user, date and time”; and step 324: “AP SYSOP bills credit card/debit card for connection.”

Moving on to the ‘Technical Field of the Invention’ what is disclosed is “[t]he invention generally relates to ... a system and method for billing, on a per connection basis”

The Background of the Invention states: “Access to data grade networks, however, is very rarely available in public locations” (col 3, lines 28 - 29); “It will thus be seen that billing systems on a per user, per connection basis are currently low considerations in the deployment of data grade networks” (col 3, lines 47 - 49); “it will be readily seen that a per user, per connection billing system will become highly advantageous” (col 3, lines 51 - 52).

The Summary of the Invention states: “The present invention allows a mobile user to obtain high speed access to ... [a] network ... while being individually billed ... for such access on a per connection basis.” (Col 4, lines 30 - 34) The Summary further states:

The enablement of this tunneled protocol further establishes a billable event for a particular remote user communication. Each time a remote user becomes connected to a home system via a tunneled protocol, the remote user and the home system necessarily become identified through execution of authorization procedures. The enablement of the tunneled protocol may further be memorialized by date, time, and AP at which the remote user is connected. This information may be stored for billing purposes on a per user, per connection basis. (Col 5, lines 43 - 52)

Other portions of the Summary make it clear that Carnegie is directed to the method by which the connection is made, while all the time staying with the notion that billing is performed on a per user, per connection basis. (Col. 4, line 41 - col 5, line 42)

The Brief Description of the Drawings states that "FIG. 3 is a flow chart illustrating an exemplary method of recording access by remote users to a data grade system of the present invention and billing pre-designated parties (advantageously either the remote user or the operator of the destination server) for such access." (Col 6, lines 47 - 52)

The Detailed Description of the Invention is replete with references to billing based on connection alone. Consider the following example, and note that the quoted passage begins with a header:

Billing on a per-user, per connection basis

It will be readily understood from the foregoing description that establishment of tunnelled IP 124 on FIG. 1 creates a billable event. In other words, when tunnelled IP 124 is established through AP 110 between portable device 101 and destination server 130 (see block 217 on FIG. 2), information regarding the event may be captured and recorded. The event may then be invoiced for by conventional means.

By way of example, and not by way of limitation, FIG. 3 is a flow chart illustrating an exemplary method of recording access by remote users to a data grade system of the present invention and billing pre-designated parties (advantageously either the remote user or the operator of the destination server) for such access. As noted, method begins at block 301 with the establishment of tunnelled IP 124 over data grade connection 122. At this point, AP 110 identifies destination server 130 to see if it is associated with a pre-established billing account holder (blocks 302 and 304). If it is, then AP 110 records, in block 306, information regarding the connection to that account holder's file, such as destination server 130, the remote user's identity (from signature information included in signals from signalling resource 105), passwords, keys, the destination server 130, as well as the date and the time that the particular tunnelled IP 124 was established. The sysop of AP 110, or

some other billing entity, then subsequently bills the account holder for the connection based on the recorded information accumulated in the account holder's file (block 308). (Col 11, line 63 - col. 12, line 23)

There are numerous other places in the disclosure where Carnegie makes clear that the sole basis for billing is a per user, per connection basis. Carnegie does not contain one scintilla of disclosure to suggest any other basis for billing, including billing based on an operation of a hardware device. As one might suspect, given the constancy of this disclosure, Carnegie's claims recite billing on a per user, per connection basis. See, e.g., claim 1.

In contrast to Carnegie, claim 1 recites:

A hardware pay-per-use system, comprising:

one or more hardware products;

a metering mechanism coupled to at least one of the one or more hardware products, wherein the metering mechanism includes a hardware device separate from the one or more hardware products, wherein the metering mechanism acquires metrics data from the one or more hardware products, the metrics data related to an operation at the one or more hardware products, and wherein the metering mechanism determines data to report on the operation of the one or more hardware products; and

a usage repository coupled to the metering mechanism, the usage repository receiving the determined data and generating usage reports related to the operation of the one or more hardware products.

As noted above, Carnegie does not disclose or suggest, *inter alia*, "a metering mechanism ... [that] acquires metrics data ... related to an operation at the one or more hardware products, and wherein the metering mechanism determines data to report on the operation" Because Carnegie does not disclose or suggest at least this element, claim 1 is patentable.

The remaining independent claims each recite features similar to those in claim 1, features that Carnegie does not disclose or suggest.

In summary, all that Carnegie discloses or suggest in terms of billing for services is that such services are billed on a per user, per connection basis. The Examiner's application of Carnegie's limited disclosure in an effort to reject claims 1 - 16 and 18 - 61 under either 35 U.S.C. §102(b) or §103(a) must, therefore, fail.

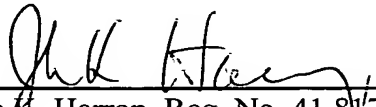
II. CONCLUSION

For at least the reasons set forth above, claims 1 - 16 and 18 - 61 are not disclosed or suggest by Carnegie.^a Therefore, Appellants respectfully request the withdrawal of the rejections and allowance of the pending claims.

No fees are believed to be due. However, should there be any additional fees required, please charge any fees required to **Deposit Account 08-2025** pursuant to 37 CFR 1.25.

Respectfully submitted,

Date: **March 10, 2008**



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^a For the sake of brevity, Appellants have not repeated the arguments made in the Appeal Brief, which Appellants maintain with respect to the rejections over Carnegie, and which have not been overcome by the Examiner's Answer.